REMARKS

Claims 1-20 are present in this application. By this Preliminary Amendment, claims 1, 4, and 7-9 are amended and claims 10-20 are added. No new matter has been added by any of the amendments or newly added claims. Support for these amendments and newly added claims may be found at least at pages 34-43 of the present specification and in Figure 14. Reconsideration of the claims in view of the above amendments and the following remarks is respectfully requested.

I. Rejection of Claims 1-9 Under 35 U.S.C. § 102(e)

The Final Office Action rejects claims 1-9 under 35 U.S.C. § 102(e) based on Kido (U.S. Patent No. 6,471,068). This rejection is respectfully traversed.

Claim 1, which is representative of the other rejected independent claims 4 and 7 with regard to similarly recited subject matter, reads as follows:

> 1. A method of handling personally identifiable information, said method comprising:
> defining a limited number of privacy-related actions regarding said personally identifiable information;
> constructing a rule for each of said privacy-related actions, wherein each rule defines an action corresponding to an associated privacy-related action, a logical condition that identifies a condition under which a particular decision is generated, and a decision indicating a manner by which said associated privacy-related action is to be performed;
> creating a programming object containing a set of rules, wherein the set of rules comprises at least one of said constructed rules;
> associating said programming object with said personally identifiable information;
> processing a request using the programming object containing said set of rules, wherein processing said request comprises:
> determining if said set of rules includes at least one rule having an action corresponding to an action specified in the request, a condition that evaluates to "true," and a decision that indicates that the action is authorized;
> selecting a rule in the set of rules that has an action corresponding to said action specified in the request, said condition

that evaluates to "true," and said decision that indicates that the action is authorized; and

providing an output based on selecting said rule in the set of rules. (emphasis added)

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). Kido does not identically show every element of the claimed invention arranged as they are in the claims. Specifically, Kido does not identically show those elements of claim 1 emphasized above.

Kido is directed to an apparatus and method for controlling access to an object. With the mechanism of Kido, a certificate and signature of a provider of the object is embedded in the object so that its security may be checked at the user side. This certificate and signature are provided along with object management information such as term's validity information which defines a valid term or a data during which the associated provider assures that contents of it's the object's data/methods is valid. All of this information may be used in the system of Kido to verify a particular object.

Kido does not teach constructing a rule a privacy-related action, wherein the rule defines an action corresponding to an associated privacy-related action, a logical condition that identifies a condition under which a particular decision is generated, and a decision indicating a manner by which the associated privacy-related action is to be performed. Kido also does not teach determining if a set of rules of a programming object includes at least one rule having an action corresponding to an action specified in a request, a condition that evaluates to "true," and a decision that indicates that the action is authorized. Furthermore, Kido does not teach selecting a rule in the set of rules that has an action corresponding to the action specified in the request, the condition that evaluates

to "true," and the decision that indicates that the action is authorized and providing an output based on selecting the rule in the set of rules.

In view of the above, Applicants respectfully submit that Kido does not teach all of the features of independent claim 1, or the similar features found in independent claims 4 and 7, as is required under 35 U.S.C. § 102(e). At least by virtue of their dependency on claims 1, 4, and 7, respectively, Kido does not teach each and every feature of dependent claims 2-3, 4-6 or 8-9. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-9 under 35 U.S.C. § 102(e).

II. Newly Added Claims 10-20

Claims 10-20 are added to recite additional features of the present invention. Claims 10-20 are dependent upon claims 1 and 4, respectively, and thus, are distinguished over Kido at least by virtue of their dependency. In addition, these claims recite additional features that are not taught or suggested by Kido. Prompt and favorable consideration of claims 10-20 is respectfully requested.

III. Conclusion

It is respectfully urged that the subject application is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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